

FEB. 2. 2005

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TTC-PA 650-326-2422

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NO. 821

P. 1

Atty Docket No. 017516-006110US

PTO FAX NO.: 703-872-9306

ATTENTION: Examiner MANTIS MERCADER, Eleni

Group Art Unit 3737

**OFFICIAL COMMUNICATION  
FOR THE PERSONAL ATTENTION OF  
EXAMINER Mantis Mercader, Eleni**

**CERTIFICATION OF FACSIMILE TRANSMISSION**

I hereby certify that the following documents in re Application of Funda, Janez

Application No. 09/595,186 filed on June 16, 2000

for System and Method for Augmentation of Endoscopic Surgery

are being facsimile transmitted to the Patent and Trademark Office on the date shown below.

Number of pages being transmitted, including this page: 31

Dated: 2 February 2005

*Nancy Pizzo*  
Nancy Pizzo

Documents Attached

1. SB/21 - Transmittal Form
2. SB/17 - Fee Transmittal (in duplicate)
3. Power of Attorney
4. Stmt. under 37 C.F.R. § 3.73(b)
5. Petition for Revival of Unintentionally Abandoned Application (2 pgs)
6. Copy of Office Action mailed on September 16, 2003 (11 pgs)
7. Amendment (12 pgs)

**PLEASE CONFIRM RECEIPT OF THIS PAPER BY  
RETURN FACSIMILE AT (415) 576-0300**

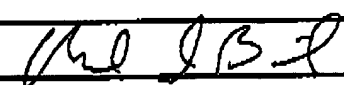
TOWNSEND and TOWNSEND and CREW LLP  
Two Embarcadero Center, Eighth Floor  
San Francisco, CA 94111-3834  
Telephone: 650-326-2400  
Fax: 650-326-2422

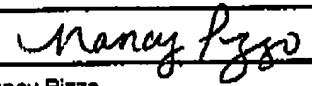
60412992 v1

PTO/SB/21 (09-04)

<b>TRANSMITTAL FORM</b>	Application Number	09/595,188
	Filing Date	June 18, 2000
	First Named Inventor	Funda, Janez
	Art Unit	3737
	Examiner Name	Mantis Mercader, Eleni
	Attorney Docket Number	017516-006110US
(to be used for all correspondence after initial filing)		
Total Number of Pages in This Submission		

ENCLOSURES (Check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input checked="" type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement  <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/ Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input checked="" type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) (please identify below): - Statement under 37 CFR 3.73(b) - Petition for Revival of Unintentional Abandoned Application under 37 CFR 1.137(b) - Copy of Office Action mailed 09/18/2003
Remarks: The Commissioner is authorized to charge any additional fees to Deposit Account 20-1430.		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT			
Firm Name	Townsend and Townsend and Crew LLP		
Signature			
Printed name	Mark D. Barrish		
Date	02/02/05	Reg. No.	38,443

CERTIFICATE OF TRANSMISSION/MAILING			
I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office, on the date stated below. Fax No. (703) 872-9306			
Signature			
Typed or printed name	Nancy Pizzo	Date	02/02/05

60412517 v1

PTO/SB/17 (12-04)

Effective on 12/08/2004.  
Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

# FEE TRANSMITTAL

## for FY 2005

☐ Applicant claims small entity status. See 37 CFR 1.27

**TOTAL AMOUNT OF PAYMENT** (\$) 1800

### Complete If Known

Application Number	09/595,186
Filing Date	June 16, 2000
First Named Inventor	Funda, Janez
Examiner Name	Mantis Mercader, Eleni
Art Unit	3737
Attorney Docket No.	017516-008110US

### METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify): \_\_\_\_\_  
☒ Deposit Account Deposit Account Number: 20-1430 Deposit Account Name: Townsend and Townsend and Crew LLP  
 For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)  
☒ Charge fee(s) indicated below ☐ Charge fee(s) indicated below, except for the filing fee  
☒ Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17 ☒ Credit any overpayments

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038

### FEE CALCULATION

#### 1. BASIC FILING, SEARCH, AND EXAMINATION FEES

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

#### 2. EXCESS CLAIM FEES

Fee Description	Small Entity Fee (\$)	Fee (\$)
Each claim over 20 or, for Reissues, each claim over 20 and more than in the original patent	50	25
Each independent claim over 3 or, for Reissues, each independent claim more than in the original patent	200	100
Multiple dependent claims	360	180

Total Claims	Extra Claims	Fee (\$)	Fee Paid (\$)	Multiple Dependent Claims	Fee (\$)	Fee Paid (\$)
22	-20 or HP = 2	50	100			
HP = highest number of total claims paid for, if greater than 20						
Indep. Claims	Extra Claims	Fee (\$)	Fee Paid (\$)			
4	-3 or HP = 1	200	200			
HP = highest number of independent claims paid for, if greater than 3						

#### 3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper, the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(a).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fee Paid (\$)
- 100 =	/ 50 =	(round up to a whole number) x		

#### 4. OTHER FEE(S)

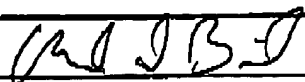
Non-English Specification, \$130 fee (no small entity discount)

Other: Petition to Revive Unintentionally Abandoned Appl. under 37 CFR 1.137(b) [1.17(m)]

**Fees Paid (\$)**
**1500**

### SUBMITTED BY

Signature



 Registration No.  
(Attorney/Agent)

36,443

Telephone 650-326-2400

Name (Print/Type)

Mark D. Barrish

Date 02/02/2005

60412976 v1

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D.821 P.7

#9 2/17/05

PATENT

Docket No.: 017516-006110US  
 Prior Ref Y0992-080D US5

Customer No. 20350

I hereby certify that this correspondence is being Facsimile  
 transmitted to the U.S. Patent and Trademark Office at the  
 following Fax No.: 1-703-872-9306

on 2 February 2005

TOWNSEND and TOWNSEND and CREW LLP

By: Nancy Pizzo

Nancy Pizzo

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of:

JANEZ FUNDA

Application No.: 09/595,186

Filed: June 16, 2000

For: **SYSTEM AND METHOD FOR  
 AUGMENTATION OF ENDOSCOPIC  
 SURGERY**

Confirmation No.: 6794

Examiner: Mantis Mercaer, Eleni

Art Unit: 3737

**PETITION FOR REVIVAL OF  
 UNINTENTIONALLY ABANDONED  
 APPLICATION UNDER 37 C.F.R. §  
 1.137(b)**

Commissioner for Patents  
 P.O. Box 1450  
 Alexandria, VA 22313-1450

Sir:

Applicants respectfully petition that the above-referenced application be revived.

This application was unintentionally abandoned for failure to respond to an Office Action mailed from the U.S. Patent Office on September 16, 2003. A copy of the Office Action is attached. That document required a response within ninety (90) days of the date of the Office Action (e.g., by December 16, 2003) so as to avoid abandonment.

Pursuant to 37 C.F.R. § 1.137(b), Applicants provide the following to accompany this Petition:

1. The required reply to the outstanding Office Action is filed herewith in the form of an Amendment.
2. Authorization is hereby granted for withdrawal of the Petition fee set forth in §1.17(m) of \$1,500.00; and

Application No.: 09/595,186  
Petition to Revive Unintentional Abandoned  
Application mailed on February 2, 2005  
Page 2

PATENT

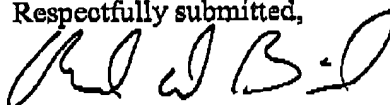
3. The entire delay in filing the required Reply, from the due for the Reply until the filing of this Petition, was unintentional.

As Applicants have complied with all requirements of 37 C.F.R. § 1.137(b) for revival of this unintentionally abandoned application, Applicants request the application be revived and advanced to issuance.

CONCLUSION

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at .

Respectfully submitted,



Mark D. Barrish  
Reg. No. 36,443

TOWNSEND and TOWNSEND and CREW LLP  
Two Embarcadero Center, Eighth Floor  
San Francisco, California 94111-3834  
Tel: (415) 576-0200 // Fax: (415) 576-0300  
MDB:nap  
Attachment: *Copy of Office Action of 09/16/03*

60377587 v1



## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Assistant Commissioner for Patents  
P.O. Box 1418  
Alexandria, Virginia 22313-1418  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/595,186	06/16/2000	Janex Funda	Y0992-080D	6794

7590

09/16/2003

IBM Corporation  
PO Box 218  
Yorktown Heights, NY 10598

TTC

EXAMINER

QADERI, RUNA S

ART UNIT

PAPER NUMBER

2737

DATE MAILED: 09/16/2003

DUE 12/16/03

Please find below and/or attached an Office communication concerning this application or proceeding.

IBM  
YORKTOWN  
2003 SEP 18 AM 10:03  
INTELLECTUAL PROPERTY  
LAW DEPT.

**Office Action Summary**

Application No.

09/595,186

Applicant(s)

FUNDA ET AL.

Examiner

Runa S. Qaderi

Art Unit

3737

**- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -**  
**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 December 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 18-24 and 37-43 is/are pending in the application.
- 4a) Of the above claim(s) 37-43 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☐ All b) ☐ Some \* c) ☐ None of:  
 1. ☐ Certified copies of the priority documents have been received.  
 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
 \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application):  
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-848)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-182)
- 6) ☐ Other: \_\_\_\_\_

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## DETAILED ACTION

### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 18-24, drawn to a method of controlling the position of a surgical instrument inside a patient's body, classified in class 600, subclass 425.
- II. Claims 37-43, drawn to a system of positioning for two or more surgical instruments relative to a patient's body, classified in class 600, subclass 407.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 808.04, MPEP § 808.01). In the instant case the different inventions are directed to unrelated systems of positioning medical devices relative to a patient's body. Invention I is directed to providing anatomical feature images to position surgical instruments inside the body, while invention II is directed to a voice recognition system that transfers commands between operator and system to position surgical instrument relative to a patient's body. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.



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During a telephone conversation with Louis J. Percello on September 2, 2003 a provisional election was made with traverse to prosecute the invention of Group I, claims 18-24. Affirmation of this election must be made by applicant in replying to this Office action. Claims 37-43 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### **Specification**

The abstract of the disclosure is objected to because it is not a single paragraph and it exceeds 150 words limit. Correction is required. See MPEP § 608.01(b).

The examiner suggests the following arrangement for the layout of the specification. Specifically examiner notes that presently in the specification "Brief Description of Drawings" precedes the "Summary of the Invention".

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

### **Arrangement of the Specification**

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)),

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and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or

REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)

**(e) BACKGROUND OF THE INVENTION.**

(1) Field of the Invention.

(2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.

**(f) BRIEF SUMMARY OF THE INVENTION.**

**(g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).**

**(h) DETAILED DESCRIPTION OF THE INVENTION.**

**(i) CLAIM OR CLAIMS** (commencing on a separate sheet).

**(j) ABSTRACT OF THE DISCLOSURE** (commencing on a separate sheet).

**(k) SEQUENCE LISTING** (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

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Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 18 and 19 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Abela et al.

The system Abela et al. teaches an angioscopic method that can designate the 3 dimensional distance of a point within the body relative to the tip of the angioscope. Column 12 lines 44 through column 13 line 56 describes the positional information that is obtained by the angioscope. The angioscope is interpreted as the first surgical instrument having means of transmitting an image outside the body. Further the point or object or scene as recited by Taylor is interpreted as the anatomical feature. Finally the recitation to manipulation of the instrument, column 12 lines 64-67, of Taylor incorporates the positioning of the first surgical instrument. Figure 10 diagrams the image-processing scheme for determining the 3-D positional information.

Claims 18, 19, and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Taylor (Pat# 5,402,801)

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in

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the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

The apparatus of Taylor, specifically Fig. 10, teaches providing the method of controlling the position of a surgical instrument as claimed in 18, 9, and 21. An system 242 comprises a surgical first instrument 254 that has imaging transmitting 266 for satisfying the applicant's limitation to a first surgical instrument transmitting an image out of the patient's body. Column 21 lines 34-41 of Taylor teach that the surgeon can designate a particular anatomical feature within the image. The transmitting image is sent to a monitor for display and to a image processor and/or computer. As taught by the applicant claims the image processor and/or computer provides relative positional information of the surgical instrument to the patient's anatomy (specifically to an anatomical feature when designated). The positional information includes location and orientation therefore providing 3-D positional information as taught by applicant. The positional information is used to move the surgical instrument to desired locations and/or to provide the desired graphical display of the anatomical feature. Regarding claims 21, Taylor teaches that a second surgical instrument can further be incorporated into the system and it's position or reposition is satisfied by the same methods as that of the first surgical instrument.

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***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 20 are 22-24 rejected under 35 U.S.C. 103(a) as being obvious over Taylor (Pat# 5,402,801).

The applied reference has a common assignment and one common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at

Application/Control Number: 09/595,188  
Art Unit: 3737

the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(I)(1) and § 706.02(I)(2).

The system of Taylor satisfies the methods of controlling the positioning a surgical instrument within a patient's body as claimed in 18, 19 and 21.

Regarding claim 20 Taylor teaches that a particular anatomical feature can be designated and further it's positional information relative to the surgical instrument can be obtained. The patent further teaches that this information can be used to modify the graphical display provided to the surgeon. Although the patent does not explicitly recite said graphical display as graphic's object superimposed on image of the anatomical feature it would have been obvious for a person of ordinary skill in the art to have provided such because it is a well known available displaying technique such that the operator can quickly and easily monitor the surgical environment. Further it is a well known expedient in the art of image guided surgery to provide for means and methods to better control and visualize the invasive procedure.

Regarding claims 22-24 Taylor teaches that surgical instrument can move in a  $\theta_x$ ,  $\theta_y$ , and  $\theta_z$  position. A desired anatomical feature can be designated the instrument can be located such that the camera scans the over an indicated path. The indicated path is interpreted as a vantage point as claimed by applicant. Further a feature "zoom" is taught by the patent such that the surgical instrument moved along an axis of view as claimed by applicant. Regarding claims 22-23 Taylor does not teach providing a constant distance between the surgical instrument and anatomical feature. Given the movement capabilities of the system of Taylor it would have been obvious to a person

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Application/Control Number: 09/595,186  
Art Unit: 3737

or ordinary skill in the art to provide the step of maintaining a constant distance. Further the system and method of Taylor does not preclude from providing movement of the surgical instrument relative to the anatomical feature in one axis or plurality of axis. This is further supported by the recitation to a "surgical path" of Taylor. A "surgical path" incorporated the path as claimed by applicant. Regarding claim 24 Taylor does not teach the incremental movement of the "zoom" function of the surgical instrument. It is obvious to one of ordinary skill in the art at the time the invention was made to provide any available motion mechanism along the axis of view because the end result of "zoom" is satisfied. The method moving incrementally to a desired zoom or moving directly to the desired zoom provided the same image.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Runa S. Qaderi whose telephone number is (703) 308-8155. The examiner can normally be reached on Mon-Fri 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dennis W. Ruhl can be reached on (703) 308-2262. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

RSQ  
RSQ

  
DENNIS RUHL  
PRIMARY EXAMINER

**Notice of References Cited**

Application/Control No.

09/595,186

Applicant(s)/Patent Under  
Reexamination  
FUNDA ET AL

Examiner

Runa S. Qaderi

Art Unit

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**U.S. PATENT DOCUMENTS**

*	Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	A US-5,036,483	07-1991	Abela et al.	382/130
	B US-5,402,801 A	04-1995	Taylor, Russell H.	128/898
	C US-			
	D US-			
	E US-			
	F US-			
	G US-			
	H US-			
	I US-			
	J US-			
	K US-			
	L US-			
	M US-			

**FOREIGN PATENT DOCUMENTS**

*	Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N				
	O				
	P				
	Q				
	R				
	S				
	T				

**NON-PATENT DOCUMENTS**

*	Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U
	V
	W
	X

\*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)  
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PTO-892 (Rev. 01-2001)

Notice of References Cited

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